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10/608,278	06/27/2003	Erik W. Selberg	RN074 (2635-012-03)	8513
72455 7590 03/04/2009 Graybeal Jackson Haley c/o RealNetworks Graybeal Jackson Haley LLP 155 - 108th Ave NE Suite 350 Bellevue, WA 98004-5973				
EXAMINER				
TRUONG, THANHNGA B				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/608,278

Applicant(s)

SELBERG ET AL.

Examiner

THANHNGA B. TRUONG

Art Unit

2435

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/18/08 (RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 18, 2008 has been entered. Claims 68-91 are pending. Claims 1-67 are cancelled, and claims 87-91 are newly added by the applicant. At this time, claims 68-91 are rejected.

Response to Arguments

2. Applicant's arguments filed December 18, 2008, with respect to claim 68 have been fully considered and are persuasive. The previous ***Claim Rejections - 35 USC § 101 and 35 USC § 112*** of claim 68-86 have been withdrawn.

However, Applicant's arguments with respect to claims 68-86 have been considered but they are not persuasive at least for ***Claim Rejections - 35 USC § 102***. New citations of the prior art also include in the office action.

Applicant has argued that:

Paragraph [0060] of the specification provides: If at the decision state 550 the player interface 122 determines that the presentation 126 is subject to a license but that the rights broker 142 has not granted the license, the process 500 moves to a state 560. At the state 560 the player interface 122 communicates to the consumer computer 120 (or its associated end-user) different options to gain access to the presentation 126 In yet another embodiment, the player interface 122 provides the consumer computer 120 with one or more license purchasing options for accessing the presentation 126. One of ordinary skill in the art will appreciate that this description discloses "providing information on how to qualify for a license" after determining that none of a plurality of licenses authorizes the requested use of the digital content.

Examiner respectfully disagrees with the applicant and still believes that the above description and/or explanation does not make up or even relevant to claim limitations of "providing information on how to qualify for a license". Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The phrase "providing information on how to qualify for a license" in claim 68 is used by the claim to mean "how to grant or purchase the license in order to access the presentation or digital content", while the accepted meaning is really "how to obtain for a license." The term is indefinite because the specification does not clearly redefine the term.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies on page 6 of the remarks (i.e., If at the decision state 550 the player interface 122 determines that the presentation 126 is subject to a license but that the rights broker 142 has not granted the license, the process 500 moves to a state 560. At the state 560 the player interface 122 communicates to the consumer computer 120 (or its associated end-user) different options to gain access to the presentation 126 In yet another embodiment, the player interface 122 provides the consumer computer 120 with one or more license purchasing options for accessing the presentation 126) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, applicant has argued that:

Spagna fails to disclose providing information on how to qualify for a license to use content when a request for a use of the content has been received but the authority to use the content as requested has not been established.

Per above explanation, Examiner respectfully disagrees with the applicant and still maintain that:

Spagna does teach this limitation in column 6, lines 35-39; column 14, lines 1-47; and column 21, lines 38-49 of Spagna, wherein Spagna teaches electronic stores coupled to a network sell licenses to play digital content data to users. Content players, which receive from the network the licensed content data, are used to play the licensed content data (column 6, lines 35-39 of Spagna). This above description equates to be the similar as "providing information on how to qualify/obtain for a license", which has been verified by the applicant as in page 6 of the remarks.

The fact that Examiner may not have specifically responded to any as indicating particular arguments made by Applicant and Applicant's Representative, should not be construed Examiner's agreement therewith.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 68 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant recites the limitation to include the language "providing information on how to qualify for a license." It is believed that giving a claim its broadest reasonable interpretation and reviewing the claim as a whole in light of the specification as understood by one of ordinary skill in the art are important steps in analyzing a claim for indefiniteness.

Applicant further recites the new added limitation to include the language "allowing the requested use of the content if at least one of the plurality of licenses authorizes the requested use." It is unclear what Applicant's intended metes and bounds of the claim are, since the claim appears to cover anything and everything that does not prohibit actions from occurring.

Claims 69-91 are depended on claim 68, thus they are rejected with the same rationale applied against claim 68 above.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 68-72, 74, 77-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Spagna et al (US 6,587,837 B1).

a. Referring to claim 68:

i. Spagna teaches a method for controlling access to digital content (**column 9, lines 52-57 of Spagna**), the method comprising:

(1) storing with the first computing device (**column 6, lines 35-39 of Spagna**) a plurality of licenses for authorizing use of the content (**column 4, lines 27-32; column 10, lines 28-33 of Spagna**) from a configurable rules that is based at least in part on a user attributes(**column 12, lines 52-67 of Spagna**);

(2) receiving with a second computing device (e.g. content player) a request to use the content (**column 10, lines 28-33 of Spagna**);

(4) determining with the second computing device (e.g. content player) whether or not at least one of the plurality of licenses authorizes the requested use of the content (**column 10, lines 28-33; column 14, lines 1-19 of Spagna**);

(5) responsive to said determination, allowing the requested use of the content if at least one of the plurality of licenses authorizes the requested use (**column 10, lines 28-57 of Spagna**); and

(5) providing with a third computing device (e.g., content player) information on how to qualify for a license, if none of the plurality of licenses authorizes the use **(column 6, lines 35-39 of Spagna)**.

b. Referring to claim 69:

i. Spagna further teaches:

(1) wherein the user attributes comprise the user's age **(column 11, lines 8-17 of Spagna)**.

c. Referring to claim 70:

i. Spagna further teaches:

(1) wherein the user attributes comprise the user's residence **(column 11, lines 8-17 of Spagna)**.

d. Referring to claim 71:

i. Spagna further teaches:

(1) wherein the user attributes comprises a payment method **(column 4, lines 22-26; column 11, lines 8-17 of Spagna)**.

e. Referring to claim 72:

i. Spagna further teaches:

(1) wherein at least one of the plurality of licenses comprises at least one grant **(column 10, lines 28-33 of Spagna)**.

f. Referring to claims 74, 84:

i. Spagna further teaches:

(1) wherein determining whether or not at least one of the plurality of licenses authorizes the requested use comprises comparing an entitlement requirement of at least one of the plurality of licenses against an attribute of a user who has made the request **(column 10, lines 28-33 of Spagna)**.

g. Referring to claim 77:

i. Spagna further teaches:

(1) wherein the requested use comprises playback **(column 5, line 51 of Spagna)**.

h. Referring to claim 78:

i. Spagna further teaches:

(1) wherein the requested use comprises copying to a compact disc **(column 53, lines 11-16 of Spagna)**.

i. Referring to claim 79:

i. Spagna further teaches:

(1) wherein the requested use comprises copying to a digital video disc **(column 53, lines 11-16 of Spagna)**.

j. Referring to claim 80:

i. Spagna further teaches:

(1) wherein the requested use comprises copying to a hard-drive **(column 53, lines 11-16 of Spagna)**.

k. Referring to claim 81:

i. Spagna further teaches:

(1) wherein the requested use comprises downloading to a portable player **(column 9, lines 58-59 of Spagna)**.

l. Referring to claim 82:

i. Spagna further teaches:

(1) wherein the rule is dynamically reconfigurable **(column 29, lines 47-50; column 31, lines 53-55; column 45, lines 22-29; column 52, lines 36-50 of Spagna)**.

m. Referring to claim 83:

i. Spagna further teaches:

(1) wherein at least one of the plurality of licenses is dynamically reconfigurable **(see Figure 5 and column 4, lines 26-32; column 39, lines 31-43 of Spagna)**.

n. Referring to claim 85:

i. Spagna further teaches:

(1) wherein providing information on how to qualify for a license comprises providing a user attribute that would allow authorization of the requested use (**column 10, lines 28-33; column 14, lines 1-19 of Spagna**).

o. Referring to claim 86:

i. Spagna further teaches:

(1) wherein providing information on how to qualify for a license comprises providing an amount of money that, if received, would allow authorization of the requested use (**column 14, lines 20-47; column 21, lines 38-49 of Spagna**).

p. Referring to claim 87:

i. Spagna further teaches:

(1) wherein the first and second computing devices are the same computing device (**see Figures 1 and 5 of Spagna**).

q. Referring to claim 88:

i. Spagna further teaches:

(1) wherein the first, second and third computing devices are the same computing device (**see Figures 1 and 5 of Spagna**).

r. Referring to claim 89:

i. Spagna further teaches:

(1) wherein the first and third computing devices are the same computing device (**see Figures 1 and 5 of Spagna**).

s. Referring to claim 90:

i. Spagna further teaches:

(1) wherein the second and third computing devices are the same computing device (**see Figures 1 and 5 of Spagna**).

t. Referring to claim 91:

i. Spagna further teaches:

(1) wherein the user attribute comprises a computing device unique identifier (**column 24, lines 37-41 of Spagna**).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 73, 75, and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spagna et al (US 6,587,837 B1), and further in view of Eichstaedt et al (US 6,108,645).

a. Referring to claims 73, 75, 76:

i. Spagna teaches the claimed subject matter via the usage of licenses and rules, However Spagna is silent on the capability of using Boolean-based expressions with its rules. On the other hand, Eichstaedt teaches this limitation in **column 2, lines 10-18; column 8, lines 25-27 of Eichstaedt.**

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Spagna with the teaching of Eichstaedt to establish a secure, global distribution system for digital content that protects the rights of content owners (**column 2, lines 56-58 of Spagna**).

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Spagna with the teaching of Eichstaedt for the secure delivery and rights management of digital assets, such as print media, films, games, and music over global communications networks such as the Internet and the World Wide Web (**column 1, lines 55-58 of Spagna**).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

/Thanhnga B. Truong/
Primary Examiner, Art Unit 2435

TBT

February 26, 2009